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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TONI PAILA, JANI PAIKELA, LIN XU,
JUHA-PEKKA LUOMA, and ROD WALSH

Appeal 2009-012730
Application 09/988,241
Technology Center 2600

Before JOHN C. MARTIN, JOSEPH F. RUGGIERO, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-47, which are all of the pending claims.

Oral argument was heard on July 21, 2010.²

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. Appellants' invention

Appellants' invention relates to performing multicast session handovers from one cell to another in a wireless system. Specification [01].³

B. The claims

The independent claims before us are claims 1, 9, 12, 23, 34, 37, and 47, of which claim 1 reads:

1. A method for performing multicast session handover, comprising the steps of:
 - (i) in a first cell, receiving from a base station corresponding to the first cell, a broadcast message communicating multicast session information for a plurality of cells comprising the first cell and a second cell;

² "[A]rguments not presented in the brief or reply brief and made for the first time at the oral hearing are not normally entitled to consideration." MPEP § 1205.02 (8th ed., rev. 7, July 2008) (citing *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980)).

³ References herein to Appellants' Specification are to the Application as filed rather than to corresponding Patent Application Publication 2003/0100325 A1.

- (ii) tuning to a multicast session in the first cell using the received multicast session information;
- (iii) when a predetermined condition occurs, tuning to the multicast session in the second cell using the received multicast session information.

Claims App. (Br. 10).

C. The references

The Examiner's rejections are based on the following references:

Das et al. ("Das")	US 2001/0036834 A1	Nov. 1, 2001
Leung et al. ("Leung '757")	US 2002/0142757 A1	Oct. 3, 2002
McCormick et al. ("McCormick")	US 6,519,455 B1	Feb. 11, 2003

Leung '757 corresponds to Application 09/933,914, filed August 20, 2001, now Patent 7,693,508 B2, issued April 6, 2010. The cover page of Leung '757, under the heading "Related U.S. Application Data," lists "Provisional application No. 60/279,970, filed on March 28, 2001" (hereinafter "Leung Provisional Application"). Appellants concede that "Leung was filed August 20, 2001, claiming priority to provisional application 60/279,970, filed March 28, 2001." (Reply Br. 2.)

D. The rejections

1. Claims 1-4, 9, 10, 12-15, 18, 19, 23-26, 29, 30, 34, 37-40, 43, and 47 stand rejected under 35 U.S.C. § 102(e) for anticipation by Leung '757. Final Action 3, para. 3.

2. Claims 5, 6, 11, 20-22, 31-33, and 44-46 stand rejected under 35 U.S.C. § 103(a) for obviousness over Leung '757 in view of McCormick. *Id.* at 9, para 5.

3. Claims 7, 16, 27, 35, and 41 stand rejected under 35 U.S.C. § 103(a) for obviousness over Leung '757 in view of Official Notice. *Id.* at 12, para. 6.

4. Claims 8, 17, 28, 36, and 42 stand rejected under 35 U.S.C. § 103(a) for obviousness over Leung in view of Das. *Id.* at 14, para. 7.

THE ISSUE

The dispositive issue raised by Appellants' arguments is whether Appellants are entitled to consideration of their argument that the subject matter relied on by the Examiner in paragraphs [0087]-[0089] of Leung '757 lacks written description support in the Leung Provisional Application.⁴

ANALYSIS

During prosecution of the Application on appeal, Appellants in June 2004 responded⁵ to a rejection⁶ based on Basillier US 2003/0073453 A1

⁴ See *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) ("If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection."). Designated as precedential at <http://www.uspto.gov/ip/boards/bpai/decisions/prec/index.jsp>.

⁵ June 2, 2004, Response to Final Office Action, at 2.

(filed October 11, 2001) with a “Declaration Under 37 C.F.R. § 1.131,”⁷ which the Examiner accepted as sufficient to remove Basilier as a reference.⁸

In October 2004, Appellants responded⁹ to a rejection¹⁰ based on Chen et al. US Patent 6,731,936 B2 (filed August 20, 2001) by filing a “Second Declaration Under 37 C.F.R. § 1.131,”¹¹ which the Examiner accepted as sufficient to remove Chen as a reference.¹² In that same Office Action, the Examiner initially entered the rejections based on Leung ‘757 that are now before us. As noted above, Leung ‘757 corresponds to Application 09/933,914, filed August 20, 2001. This is the same filing date as the filing date of the Chen reference that was antedated by the “Second Declaration Under 37 C.F.R. § 1.131.”

Appellants argue for the first time in the Reply Brief that in view of the Examiner’s acceptance of the “Second Declaration Under 37 C.F.R. § 1.131” as effective to overcome Chen, “Leung . . . is . . . valid as a reference only insofar as it is supported by the provisional application filed March 28, 2001,” and that the rejections are improper because the subject matter relied on in paragraphs [0087]-[0089] of Leung ‘757 lacks written description support in the Leung Provisional Application (*id.* at 2).

⁶ Office Action mailed April 19, 2004, at 2, para. 3.

⁷ Ex. 1 to Reply Br.

⁸ June 22, 2004, Final Action, at 2, para. 1.

⁹ October 1, 2004, Amendment, at 2.

¹⁰ June 22, 2004, Final Action, at 2, para. 4.

¹¹ Ex. 2 to Reply Br.

¹² Non-final Office Action mailed June 3, 2005, at 2, para. 1.

In the absence of any clear indication to the contrary, we assume the Examiner recognized that the August 20, 2001, filing date of Leung '757 has been antedated by the "Second Declaration Under 37 C.F.R. § 1.131" and that Leung '757 is therefore effective as a reference only to the extent it is supported by the Leung Provisional Application. *See* MPEP § 2136.03 (III) (8th ed., rev. 7, July 2008) ("The 35 U.S.C. 102(e) critical reference date of a US patent or US application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."). Appellants do not argue in the Brief or the Reply Brief that the Examiner failed to recognize that the August 20, 2001, filing date of Leung '757 has been antedated by the "Second Declaration Under 37 C.F.R. § 1.131."

Appellants' argument that the subject matter relied on in paragraphs [0087]-[0089] of Leung '757 lacks written description support in the Leung Provisional Application (*id.* at 2) is entitled to no consideration because it was not necessitated by a new point in the Answer and thus should have been made in the opening Brief. *See Ex parte Borden*, 93 USPQ2d 1473, 1473-74 (BPAI 2010) ("informative"¹³) (absent a showing of good cause,

¹³ Designated as an "Informative Opinion" at <http://www.uspto.gov/ip/boards/bpai/decisions/inform/index.jsp>.

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the Board is not required to address an argument newly presented in the Reply Brief that could have been presented in the principal Brief on Appeal). Appellants' assertion that "[p]rior to the Examiner's Answer, the Office had not relied on paragraphs [0087]-[0089] of Leung" (Reply Br. 2) overlooks the Examiner's reliance on paragraphs "0087-0088" at pages 4-8 of the Final Action and on paragraph "0089" at pages 2, 4-6, and 8 thereof.

The Examiner's rejections are therefore affirmed.

DECISION

All of the Examiner's rejections are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(v) (2010).

AFFIRMED

babc

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606